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Claims 30-44 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 5.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Makower or <sup>Ishihara</sup> Edwards et al in combination with ~~Ishikawa~~ et al. Makower and Edwards et al teach a device such as claimed except the blunt periphery, the use of platinum, band type sensor, thermistor type <sup>Ishihara</sup> sensors, resistive heater or the use of potting compound. ~~Ishikawa~~ et al teach the equivalence of <sup>Ishihara</sup> blunt and pointed peripheries. It would have been obvious to the artisan of ordinary skill to employ a blunt periphery in the devices of Makower or Edwards et al, since these can function similarly and to employ the sensors, heaters, electrode material, sensor location and potting compound fixation, since these are not critical, provide no unexpected result and are notorious throughout the art for performing these functions, official notice of which has been taken, thus producing a device such as claimed.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.

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Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-29 are rejected under the judicially created doctrine of double patenting over claims 1-22 of U. S. Patent No. 5,458,596 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: all claimed subject matter.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

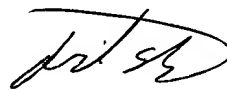
Applicant notes that Makower is intended to be used which puncturing tissue, there is nothing in the structure of Makower (or Edwards) that prevents it from being used without penetrating the surface of the selected site.

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Applicants arguments are noted, but are drawn to the way in which the device is used, rather than the structure thereof and as such are not convincing.

Applicant's arguments filed October 9, 1998 have been fully considered but they are not persuasive.

Any inquiry concerning this communication should be directed to David Shay at telephone number (703) 308-2215.



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March 30, 1999